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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,841	05/30/2001	Michael C. Chen	8932-193	7253
20582	7590	04/29/2004		
JONES DAY			EXAMINER	
51 Louisiana Aveue, N.W			ODLAND, KATHRYN P	
WASHINGTON, DC 20001-2113			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,841

Applicant(s)

CHEN, MICHAEL C.

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-37 is/are pending in the application.
- 4a) Of the above claim(s) 10-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9 and 26-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 10-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the paper dated March 22, 2004.

DETAILED ACTION

Response to Amendment

This is a response to the amendment dated January 6, 2003. Claims 1-37 are pending.

Response to Arguments

1. Applicant's arguments filed January 6, 2003 have been fully considered but they are not persuasive.

Regarding claims 1 and 8, applicant argues, "There is no disclosure, teaching or suggestion in Larsen of an insertion device having a longitudinal member and a shaft wherein the longitudinal member comprises a first and a second member movable with respect to one another and wherein the longitudinal member is also movable with respect to the shaft." However, the examiner respectfully disagrees. Larsen discloses an insertion device having a longitudinal member (250 and 270 with related components) and a shaft (260) wherein the longitudinal member comprises a first (250) and a second member (270 and related components) movable with respect to one another, as recited in column 7, lines 50-58 and column 8, lines 1-15, for example. Further, the

longitudinal member is also movable with respect to the shaft. Applicant attention is also directed to claim 1 of Larsen.

Regarding claim 8, applicant argues, "There is no disclosure, teaching or suggestion in Larsen of an insertion device having an outer longitudinal member that is movable with respect to the shaft so that the distal end of the shaft contacts the head of the fixation element." However, the examiner respectfully disagrees. As recited in column 6, claim 1, and throughout the specification, Larsen's device has an outer longitudinal member (250 and 270 with related components) that is movable with respect to the shaft (260) so that the distal end of the shaft (260) contacts the head of the fixation element. Column 6, lines 15-20 recite, "Referring to FIGS. 5-7, plunger rod 260 is slidably disposed within bore 254 of sheath tube 250, and includes a distal end portion 261 which includes openings 267 to releasably engage the proximal end portion of legs 15 of the suture anchor, and two slots 262 which permit passage therethrough of the suture 30." The shaft releasably engages the proximal end portion of the legs.

Regarding claim 9, applicant argues, "There is no disclosure, teaching or suggestion in Larsen of an insertion device having an elongated sleeve adapted to hold the head portion of a tack and a shaft positioned within the elongated sleeve adapted to contact the head of the tack when a force is applied. Rather, Larsen discloses an outer sheath tube and an inner plunger rod, wherein the inner plunger rod has an opening in the distal end thereof for holding the suture anchor. The outer sheath tube does not hold the suture anchor." However, the

examiner respectfully disagrees. Applicant's attention is directed to column 6, lines 5-8, which recite, "The distal end of the sheath tube acts as the primary support for the suture anchor 10."

Applicant has failed to define structural features that define over the prior art rejection. The rejection is reiterated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-9, and 26-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsen in EP 0834281.

Regarding claim 1, Larsen discloses a device having a longitudinal member (250 and 270 with associated components) extending along a longitudinal axis from a proximal end to a distal end and having a channel (254 and between 272) extending therein adapted for receiving at least a portion of one fixation element, as recited in column 6 and seen in figure 5; and a shaft (260) positioned coaxially within and extending along at least a portion of the longitudinal member, at least a portion of the shaft retained within the channel of the longitudinal member and having a distal end configured and adapted to contact at least a portion of the fixation element, wherein the longitudinal member is moveable with respect to the shaft to drive the fixation element into bone;

wherein the longitudinal member includes a first member (250) for receiving at least one fixation element at the distal end and a second member (270 and related components) attached coaxially to the first member, and the first member is movable with respect to the second member, as recited by Larsen in columns 5-7, claim 1 and seen in figure 5 and discussed above in the Response to Arguments section.

Regarding claims 3, 26 and 32, Larsen discloses that as applied to claims 1, 8 and 9, as well as, a spring (240) housed within the channel (via between 272) and engaging the first member for resiliently biasing the first member in the axial direction, as seen in figure 5.

Regarding claims 4, 27 and 33, Larsen discloses that as applied to claims 1, 8 and 9, as well as, first (250) and second members (270) that are **substantially** cylindrical and the first member is movable telescopingly within the second member, as recited throughout the specification and seen in figure 5.

Regarding claims 5, 28 and 34, Larsen discloses that as applied to claims 1, 8 and 9, as well as, first (250) and second (270) members that are interlocked in the axial direction, as seen in figure 5.

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Regarding claims 6, 29 and 35, Larsen discloses that as applied to claims 1, 8 and 9, as well as, a shaft that is substantially cylindrical and has at least two portions with different diameters (portion 261 has a smaller diameter than 260), as seen in figure 5.

Regarding claims 7, 30 and 36, Larsen discloses that as applied to claims 1, 8 and 9, as well as, a distal end of the longitudinal member (250 and 270 with associated components) that includes a pronged tip that is capable of resiliently holding a fixation element therein, as recited throughout the specification and seen in figure 5.

Regarding claim 8, Larsen discloses a device having a handle member (such as 210) adapted for being held by a user and having a recess extending therein; a longitudinal member (250 and 270 with associated components) extending along a longitudinal axis from a proximal end to a distal end and having a channel (via 272 and 251) extending therein adapted for receiving at least a portion of one fixation element, the proximal end of the channel communicating with the recess in the handle member, as seen in figure 5; and a shaft (260) positioned coaxially and extending within at least a portion the channel of the longitudinal member, the shaft (260) coupled to the handle at a proximal end, and having a distal end adapted to contact at least a portion of the fixation element when the fixation element is driven into the bone, wherein the

longitudinal member is moveable with respect to the shaft so that the distal end of the shaft contacts the head of the fixation element to drive the fixation element into bone, wherein the longitudinal member includes a first member (250) for receiving the at least one fixation element at the distal end and a second member (270) attached coaxially to the first member, the first member being movable with respect to the second member, as recited in columns 5-7 and seen in figure 5 of Larsen and discussed above in the Response to Arguments section.

Regarding claim 9, Larsen discloses a device having a handle (such as 210) adapted for receiving a force from a user, the handle having a recess extending therein; an elongated sleeve (250 with 270 and associated components) having a longitudinal axis, a proximal end, a distal end, and a hollow portion extending along the longitudinal axis between the proximal end and the distal end, the hollow portion of the sleeve communicating with the recess in the handle to form a channel, the sleeve telescopingly moveable with respect to the handle, the sleeve adapted to hold the head portion of the tack; a shaft (260) at least a portion of which extends within the channel, the shaft having a proximal end fixedly attached to the handle and a distal end adapted to contact the head of the tack when it is driven into the bone, the shaft also having an enlarged head portion; and a spring (240) housed within the channel and coaxial with the shaft (260), the spring engaging the head portion of the shaft and at least one of the sleeve and handle, wherein when a force is applied to the

handle, the channel shortens in length and the distal end of the shaft contacts the head of the bone tack and drives the bone tack into bone, as recited in columns 5-7 in Larsen and discussed above in the Response to Arguments section.

Regarding claim 31, Larsen discloses that as applied to claim 9, as well as, an elongated sleeve that includes a first member (250) for receiving the at least one fixation element at the distal end and a second member (270) attached coaxially to the first member, the first member being movable with respect to the second member, as recited in columns 5-7 and seen in figure 5 of Larsen and discussed above in the Response to Arguments section.

Regarding claim, 37, Larsen discloses that as applied to claim 1, as well as, a handle (such as 210) adapted for being held by a user and having a recess extending therein for receiving the proximal end of the longitudinal member and shaft, as seen in figure 5.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO


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